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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,328	09/10/2003	Paul Spaeth	16222U-011310US	5961
66/945 7590 06/15/2009 TOWNSEND AND TOWNSEND CREW LLP TWO EMBARCADERO CENTER, 8TH FLOOR SAN FRANCISCO, CA 94111				
EXAMINER				
RETTA, YIHDEGA				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/660,328

Applicant(s)

SPAETH ET AL.

Examiner

Yehdega Retta

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-20, 35-51, 53 and 55-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-20, 35-51, 53 and 55-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to amendment filed May 9, 2009. Claims 1, 7, 13, 35-37, 39-41, 43, and 46 have been amended, claims 8, 21-34, 52 and 54 have been canceled and claims 56-58 have been added. Claims 1-7, 9-20, 35-51, 53, 55-58 are currently pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 35-51 and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by DiRaimondo et al. (US 7,032,047).

Regarding claims 35-38, DiRaimondo teaches *means for* receiving a request for changing the participation status from a first status to a second status; *means for* receiving card image data from the portable device, the card image data including a parameter indicating the participation

status as having the first status for the portable device; *means for* modifying the parameter in the card image; *means for* updating the card image data in the portable device; *means for* establishing a connection with the portable device to allow the card image data to be received (see fig. 6A, 6B, col. 10 line 30 to col. 11 line 45) *means for* sending an indication to a host indicating that the parameter in the portable device was modified (see col. 4 lines 42-59).

Regarding claim 39, DiRaimondo teaches a network computing device configured to communicate with the portable device the networked device comprising (card reader interface); *means for* establishing a connection with the portable device; *means for* receiving a request from the loyalty program participant for changing the participation status from a first status to a second status; *means for* receiving card image data from the portable device, the card image data including a parameter indicating the participation status as having the first status (see fig. 6A, 6B, col. 10 line 30 to col. 11 line 45);

a loyalty server module component configured to communicate with the networked computing device and receive the sent card image data, wherein the loyalty server module comprises : *means for* modifying the parameter in the card image data, the modification of the parameter corresponding to a change of the participation status from the first status to the second status; and *means for* sending the modified card image data to the networked computing device, wherein the networked computing device further comprises *means for* updating the card image data in the portable device with the modified card image data, the modified parameter indicating the participation status as having the second status (col. 10 line 33 to col. 11 line 33).

Regarding claims 40-42, DiRaimondo teaches *means for* communicating through a network to establish a connection with the loyalty server module (see fig. 6A, 6B, col. 10 line 30 to col. 11 line 45); *means for* receiving a transaction ID from the loyalty server module; *means for* using the transaction ID to connect to the loyalty server module through the network (see col. 5 lines 34-67, col. 9 line 20 to col. 10 line 31)); teaches wherein the participation status includes one of a plurality of levels, which includes an account level, a card level, a program level and a transaction level (see col. 4 lines 6-56).

Regarding claims 43-45, DiRaimondo teaches providing a parameter in the portable device, the parameter indicating the status of the portable device for the loyalty program; and providing a modifying mechanism to modify the parameter in the portable device *in response to a request by a loyalty plan participant (see fig. 6A, 6B, card reported lost stolen or found by the cardholder)*, the modification of the parameter corresponding to a change of the participation status in the loyalty program from a first status to a second status for the portable device; providing card image data, the card image data including the parameter; wherein the portable device comprises at least one of a smartcard, a cellular phone, a personal digital assistant (PDA), a pager, a payment card, a security card, an access card, smart media and a transponder (see fig. 2A-2C, col. 6 line 55 to col. 7 line 17).

Regarding claims 46-51 and 55, DiRaimondo teaches a portable device configured to include card image data, the card image data including information relating to the loyalty program participant and a parameter that corresponds to a participation status, the participation status having a first status or a second status and representing whether participation in the loyalty program is active or inactive; and a computing device configured to: receive an indication *from*

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the loyalty program participant to change the participation status from the first status to the second status, modify the card image data including the parameter, wherein modification of the parameter corresponds to a change of the participation status from the first status to the second status, and update the portable device with the modified card image data; wherein the computing device is further configured to modify the card image data by retrieving the card image data from the portable device and modifying the retrieved card image data; and wherein the computing device is further configured to update the portable device by uploading the modified card image data to the portable device and replacing the card image data on the portable device with the modified card data image; wherein the computing device comprises at least one of an acceptance point device, a personal computer (PC), a workstation, a personal digital assistant (PDA), a cellular phone, a set-top box, a kiosk, and a tablet PC; wherein the acceptance point device includes a point-of-sale device; wherein the portable device comprises at least one of a smartcard, a cellular phone, a personal digital assistant (PDA), a payment card, a pager, a security card, an access card, smart media and a transponder; wherein the computing device is further configured to send an indication to a host indicating that the parameter in the portable device has been modified; wherein the indication to change the participation status from the first status to the second status is received from the loyalty program participant; wherein the indication to change the participation status from the first status to the second status is received from a host managing the loyalty program; wherein if the first status is an active status, then the second status is an inactive status, and if the first status is an inactive status, then the second status is an active status (see fig. 1-2C, col. 6 line 55 to col. 7 line 17, col. 11 lines 4-45).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9-20, 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiRaimondo et al. (US 7,032,047) in view of Rochman et al. (US 2002/0139844).

Regarding claims 1, 39-42, 56, DiRaimondo teaches *after a portable device has been activated receiving by an acceptance point device an indication to change the participation status in the loyalty program from a first status to a second status; and modifying a parameter in the portable device using the acceptance point device from a first value to a second value in response to the indication, the modification of the parameter corresponding to a change in the participation status in the loyalty program from the first status to the second status* (see col. 5 line 10 to col. 6 line 45). DiRaimondo teaches (see fig. 4, 5) the customer reports to the customer service center that the card is lost, stolen or found (the card to be disable or enabled, i.e., a change of status); when the card is presented at the card acceptance location (acceptance point device) the parameter of the card is modified. Therefore, DiRaimondo teaches that the indication to change the status of the card is initiated by the participant. DiRaimondo does not teach the acceptance point device receiving the indication ***directly*** from the user. However Rochman teaches an acceptance point device modifying the parameter after receiving an indication of change of participation status ***directly*** from the card holder (see [0066], [0070]). It would have been obvious to one of ordinary skill in the art at the time of the invention to change the status of

DiRaimondo's card in the manner taught in Rochman in order to provide an option for the card holder to directly alter the status of the card.

Regarding claims 2-7, 10-12, DiRaimondo teaches receiving card image data from the portable device, the card image data including the parameter having the first value, the first value indicating the participation status as having the first status; further comprising modifying the parameter in the card image data from the first value to the second value; comprising sending an indication that the parameter in the portable device was modified from the first value to the second value to a host; further comprising changing a record for the status of the portable device to the second status at the host; wherein if the first status is an active status, the second status is an inactive status, and wherein if the first status is an inactive status, the second status is an active status; wherein the indication to change the participation status is received at an acceptance point device; and wherein the acceptance point device is configured to communicate with the portable device; wherein the indication to change the participation status is provided by the loyalty program participant or a host managing the loyalty program (see fig. 6A, 6B, col. 10 line 30 to col. 11 line 45); teaches wherein the participation status includes one of a plurality of levels, which includes an account level, a card level, a program level and a transaction level (see col. 4 lines 6-56).

Regarding claim 9, DiRaimondo teaches therein the indication to change the participation status is received at a computing device connected to the Internet (col. 2 lines 24-44, col. 9 lines 44-55).

Regarding claims 13-20, DiRaimondo teaches receiving a request for changing the participation status from a first status to a second status; receiving card image data from the

portable device, the card image data including a parameter indicating the participation status as having the first status; modifying the parameter in the card image data, the modification of the parameter corresponding to a change of the participation status from the first status to the second status; and updating the card image data in the portable device with the modified parameter, the modified parameter indicating the participation status as having the second status; comprising establishing a connection with the portable device to allow the card image data to be received; sending an indication to a host indicating that the parameter in the portable device was modified; changing a record for the status of the portable device to the second status at the host (see fig. 6A, 6B, col. 10 line 30 to col. 11 line 45); teaches wherein the participation status includes one of a plurality of levels, which includes an account level, a card level, a program level and a transaction level (see col. 4 lines 6-56).

Regarding claims 57 and 58, DiRaimondo as modified by Rochman is silent to returning an error message to the portable device if the first status is the same as the second status. Official notice is taken that is old and well known in the art of programming to provide an error message. It would have been obvious to one of ordinary skill in the art at the time of the invention to include an error message if the existing status of the card is the same as the requested status change, in order to inform the card holder of the current status of the card.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over DiRaimondo as applied to claim 41 above, and further in view of McDonald et al. (US 6,736,317).

Regarding claim 53, DiRaimondo teaches receiving indication to change the status by customer (see col. 4 lines 33-41), however failed to explicitly teach a graphical user interface used to provide the indication. McDonald teach graphical user interface used provide indication of change to participation status (fig. 4 and col. 8 lines 1-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the graphical user interface of McDonald in DiRaimondo's method of regulating smart card usage and/or concession in order to allow the user to contact the system via any available means, as in McDonald.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Manduley (US 5737423) teaches smart card having a remote inspection capacity.

Hoss (US 5412192) teach remotely changing the card appearance or information contained in the card so as to change the status of the card (e.g., from active to inactive).

Allen (US 2002/0102975) teaches providing different options to use the card.

Mollett et al. (US 6505772) teaches utilizing a single card to provide multiple services.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/

Primary Examiner, Art Unit 3622